

DOCKET NO: 263493US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
JOHANN BONN, ET AL. : EXAMINER: METZMAIER, D. S.
SERIAL NO: 10/519,405 :
FILED: JANUARY 5, 2005 : GROUP ART UNIT: 1796
FOR: DEFOAMING AGENT AND/OR :
DEAERATORS FOR AQUEOUS MEDIA
TENDING TO FOAM

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The following Reply Brief is in reply to the Examiner's Answer dated December 26, 2008 (Answer).

The statement of the Grounds of the Rejection (Answer at 3-4) is essentially identical to the statement in the Final Rejection. The difference is that the term "alkoxylated fatty alcohols of 12-26 carbon atoms" no longer appears in the claims, in view of the amendment filed November 19, 2008, which amendment has been entered, in accordance with the Advisory Action dated December 4, 2008. Applicants also note that the amendment moots the rejection stated under Ground (B) in the Appeal Brief, as acknowledged in the Answer (Answer at 2). The rejection still pending from the Final Rejection has already been responded to in the Appeal Brief. The following is in reply to the "Response to Argument" (Answer at 4-7).

The Examiner continues to find that *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977) is inapposite. Particularly, the Examiner finds that Applicants' analysis, which focuses on the hydrophobic compound component of the claims, ignores the other components of the claims, i.e., component (i) and component (ii) (Answer at 5). Particularly, the Examiner finds that *Johnson* is contrasted by the fact (1) that components (i) and (ii) are obtained from starting materials indistinguishable from the fatty acids explicitly excluded from the recited dispersion, and (2) that components (i) and (ii) are drafted in product-by-process format. (*Id.*)

In reply, Applicants have already addressed the first stated contrast in the Appeal Brief. With regard to the second stated contrast, only component (i) is recited in product-by-process format and, as pointed out in the Appeal Brief, the only excess contemplated for component (i) is the polyglycerol, not the carboxylic acid. Component (ii) is not recited in product-by-process format, but rather simply as the product of two precursor reactants. Even if such recital is construed as product-by-process format, its relevance would appear to be missing. As Applicants have argued in the Appeal Brief, component (i) is an ester; component (ii) is a bisamide.

The Examiner improperly puts the burden on Applicants to provide disclosure in the specification describing either the use of components (i) and (ii) as purified materials or the result of separation of excess fatty acids (Answer at 6).

In reply, no precedent is known which puts such a burden on Applicants. In addition, it is clear from the specification that components (i) and (ii) are each old in the art and recognized as such by Applicants, such components known as polyglyceryl esters and bisamides, respectively. Indeed, a major aspect of the present invention is the use of components (i) and (ii) together which, as Applicants describe in the specification at page 20, lines 17-19, results in an improved effect compared with the use of the individual

components. Thus, the present invention is not at all concerned with how components (i) and (ii) are made. It is clear that Applicants chose component (i) because it is a polyglyceryl ester, not because it is derived from a fatty acid, and chose component (ii) because it is a particular bisamide, not because it is derived from a fatty acid.

The Examiner finds that the present claims are generic and therefore, one skilled in the art must look to the specification to interpret the claims and thus, since both components (i) and (ii) “are disclosed and claimed to include 100% of the N (nitrogen) and OH (hydroxyl) be condensed with fatty acids[, it] is not unreasonable to expect the presence of excess or unreacted fatty acids” (Answer at 7).

In reply, the specification makes clear, as discussed above, that component (i) is a polyglycerol **ester**, and component (ii) is a particular **bisamide**. Based on the specification as a whole, it is clear that Applicants had possession, as of the present filing date, the presently-recited three-component dispersion comprising a combination of at least one polyglyceryl ester, at least one particular bisamide, and at least one hydrophobic compound selected from a group of materials not including fatty acids, which dispersion excludes fatty acids of 12 to 26 carbon atoms and alkoxylated fatty alcohols.

Applicants maintain that the one remaining rejection from the Final Rejection should be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



Harris A. Pitlick
Registration No. 38,779

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)